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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/342,680 06/29/99 ANDERSON

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EXAMINER

TM02/0309

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ART UNIT

PAPER NUMBER

2176

DATE MAILED:

03/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/342,680

Applicant(s)

ANDERSON ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 12/19/00 to the application filed on 06/29/99.
2. Claims 1-20 are pending in the case. Claims 1, 8, 13 are independent claims.
3. The rejections of claims 2 and 4 under 35 U.S.C. 112, second paragraph, as being indefinite have been withdrawn in view of the amendment.
4. The rejections of claims 1-20 under 35 U.S.C. 103(b) as being anticipated by Narayan et al. (6,035,323) have been withdrawn as pursuant to the applicant's argument.

Drawings

5. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

6. It is requested that the current status of the co-pending US application 09/059,611 (page 1) be updated.

Information Disclosure Statement

7. The information disclosure statement filed 6/29/99 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the references from the internet site does not have the published date. It has been placed in the application file,

but the information referred to therein has not been considered as to the merits.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections – 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 8, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu (US Pat No. 5,848,420 12/8/98, filed 6/14/96) in view of Narayen et al. (US Pat No. 6,035,323, 3/7/00, filed 10/24/97).

Regarding independent claim 1, Xu discloses:

- connection between the digital camera and the computer (figure 1; col 3, lines 55-67 to col 4, lines 1-3; col 4, lines 30-45)
- mounting the image capture device as a disk on the host computer (abstract; col 2, lines 15-35)

Xu does not disclose generating the image files stored in the digital camera into HTML format and opening these files in the computer system without loading any camera-specific software.

Narayen discloses:

- generating an Internet page description file in the image capture device that references the images stored therein (figure 1, steps 10, 12; figure 5, steps 225, 229)
- opening the Internet page description file in a web browser on the host computer, wherein the images stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer (figure 4, col 7, lines 14-48)
- establishing communication between the image capture device and the host computer (col 5, lines 50-67; col 6, lines 28-45)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Xu into Narayen since Xu and Narayen are directed to a digital camera connecting a computer. Such combination will give users the convenience of accessing and browsing image files in the digital camera mounted in the operation system of the computer as browsing HTML files using a web browser.

Claims 8,13 are for the system and the computer-readable medium of method claim 1, and therefore are rejected under the same rationale.

Regarding claims 11-12, it was obvious that the Internet page is a HTML page and images are transferred from a digital camera to the host computer and the Internet as disclosed above.

11. Claims 2-5, 9-10, 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu and Narayen as applied to claim 1 above, and further in view of Cohen et al. (US Pat No. 5,805,829, 9/8/98, filed 10/1/96).

Regarding claim 2, which is dependent on claim 1, Narayen and Xu do not disclose the providing of Java files with the Internet page description files in the image capture device.

Cohen discloses that a web page can include programs of Java files called applets for execution live images of the web page content (col 1, lines 20-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Cohen into Narayan and Xu for providing Java files along with the internet page file for executing images captured from the image capture device connected to the host computer.

Regarding claim 3, which is dependent on claim 2, it was well-known that compressing is applied for easy transferring image files, which can be Java files as in Cohen, with a large amount of data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that said files should be executed for decompressing and for displaying on the web browser.

Regarding claim 4, which is dependent on claim 3, Narayan discloses the generating the Internet page description when the communication with the host computer is indicated (figures 1, 4, 8).

Regarding claim 5, which is dependent on claim 4, Narayan discloses the storing of the images displayed in the web browser on the host computer by copying the compressed images files from the image capture device directly to the host computer (col 6, lines 31-45).

Claims 9-10, 14-18 are for the system and the computer-readable medium of method claims 2-5 and therefore are rejected under the same rationale.

12. Claims 6-7, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xu and Narayen as applied to claim 5 above, and further in view of Wang et al. (US Pat No. 6,058,428, 2/5/00, filed 12/5/97).

Regarding claim 6, which is dependent on claim 5, Xu and Narayen do not disclose the copying of image files, which is determined not being previously copied, to the host computer.

Wang discloses:

- determining if any of the compressed image files have previously been copied to the host computer (col 5, lines 59-67; col 6, lines 42-50)
- copying only the compressed image files to the host computer that have not been previously copied (col 5, lines 59-67; col 6, lines 42-50)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Wang into Narayen to enhance that feature to Xu and Narayen to avoid the duplicate files when copying.

Regarding claim 7, which is dependent on claim 6, Narayen discloses:

- uploading the image files and the internet page description file to the host computer (figures 4, 5, 9)
- opening the internet page description file in the web browser on the host computer to display the images stored in the host computer (figures 4, 5, 9)

Though Narayen does not explicitly disclose the computer on which the web page displayed is the host computer. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have recognized that said computer is a host computer as claimed since it is connected to the digital camera and is where to display images from the digital camera.

Claims 19-20 are for the computer-readable medium of method claims 6-7, and therefore are rejected under the same rationale.

Response to Arguments

13. Applicant's arguments with respect to claims 1, 8, 13 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Narayen does not teach or suggest "automatically generating an Internet page description file *in the image capture device* that references the images stored *therein*."

Examiner disagrees. Narayen, as admitted by applicants, is directed to generating Internet pages that references images from a digital camera (Narayen, col 7, lines 40-44). In addition, Narayen does teach that feature in figure 5; col 7, lines 38-48; col 8, lines 7-21).

Applicants argue that Narayen does not disclose "mounting the image capture device so that it appears to the host computer as a disk, the user may access the device without loading a camera-specific software."

Examiner agrees. The reference Xu (5,848,420), submitted by Applicants, discloses that feature (abstract, figure 3, col 2, lines 15-35).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tsutsui (US Pat No. 5,640,204, 6/1997) teaches a method and system for processing DOS information within a digital still camera.

Boggs et al. (US Pat No. 6,122,409, 9/19/00, filed 8/29/97) teaches a system and method for digitally capturing a product image.

Garfinkle (US Pat No. 6,161,131, 12/12/00, filed 10/02/98) teaches digital real time postcards including information such as geographic location or landmark.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is (703)-305-0432. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

Art Unit: 2176

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. The fax number to this Art Unit is (703) 308-5403.

16. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5403 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA. Sixth Floor (Receptionist).

clh

2/26/01


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